UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,402	07/24/2003	Masaki Kamiya	P/1927-10	1069

2352   7590   09/12/2007
OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER
ADDY, ANTHONY S

ART UNIT	PAPER NUMBER
2617	

MAIL DATE	DELIVERY MODE
09/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/626,402	KAMIYA, MASAKI
	Examiner	Art Unit	
	Anthony S. Addy	2617	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 June 2007</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-12,14-23 and 25-33</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,3-12,14-23 and 25-33</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date <u>04/16/2007 & 07/02/2007</u>.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to applicant's amendment filed on June 15, 2007.

Claims 1, 3, 4-12, 14-23 and 25-33 are pending in the present application.

Information Disclosure Statement

2.   The references listed in the Information Disclosure Statement filed on April 16,

2007 and July 02, 2007 has been considered by the examiner (see attached PTO-1449

form or PTO/SB/08A and 08B forms).

Response to Arguments

3.   Applicant's arguments with respect to **claims** 1, 3, 4-12, 14-23 and 25-33 have

been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

5.   Claims 1, 3, 4-12, 14-23 and 25-33 are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Nielsen et al., U.S. Publication Number 2001/0030663 A1**

(hereinafter Nielsen) and **Oosterholt et al., U.S. Publication Number 2001/0008399**

A1 (hereinafter Oosterholt) and further in view of **Kinnunen et al., U.S. Publication**

Number 2001/0021649 (hereinafter Kinnunen).

Regarding claim 1, Nielsen teaches a communication terminal accessible to a communication network (see paragraph 0032, lines 3-9, paragraph 0026, lines 6-10 and paragraph 0042, lines 3-5), said communication terminal including: a display unit (see paragraph 0026, lines 3-5 and Figures 1 & 2; where a display unit [LCD 3] is shown); and a control unit configured to control said display unit in displaying, in a stand-by mode of said communication terminal (see paragraph 0034, line 1 through paragraph 0035, line 3, paragraph 0039, lines 6-18, Fig. 2; where a control unit [processor 18] configured to control display unit [LCD 3] is shown, and Fig. 4a; where layout 30 as presented on LCD 3, showcases the phone in an idle mode), at least one of: a first display mark which provides a reference information linked to past-referred to data stored in said communication terminal (see paragraph 0039, lines 18-25 and Fig. 4a; where Names 60 on LCD 3 enables the user of the phone to access a built in phone book which reads on past-referred data stored in the phone); and a second display mark which provides at least one executable function related to said past-referred to data (see paragraph 0039, lines 18-25, paragraph 0040, lines 1-3, paragraph 0042, line 1 through paragraph 0043, line 9 and Fig. 4a; shows the steps of selecting among several different menu items [Names 60 or Menu 55] listed on LCD 3 when the phone is in an idle mode).

Nielsen, however, fails to explicitly teach a third display mark which provides an access-related information allowing said communication terminal to access a past-referred to file stored in a computer device connected to said communication network, and said access-related information being linked to said file; and a fourth display mark

which provides at least one executable function related to said past-referred to file, said

reference information having been automatically created in a normal operation mode of

said communication terminal when said past-referred to data was referred to, and said

past-referred to file having been referred to in communication mode of said

communication terminal.

Oosterholt, however, teaches a personal computer accessible to a

communication network, wherein the personal computer enables a user to browse web

pages by means of a bookmark (see paragraph 0017, lines 1-5, paragraph 0018, lines

10-11). According to Oosterholt, the user may select a bookmark from a list of earlier

defined bookmarks, which causes a retrieval means to retrieve a webpage referenced

by the selected bookmark and the retrieval means may download the requested page

from a remote server or if the page is already available locally, retrieve it from an

internal storage medium (see paragraph 0018, lines 10-17 and Fig. 1; shows a personal

computer 101 connected to a remote internet server 102). Oosterholt further teaches

the web-pages may be selected by a history means, which maintain a list of references

to web-pages which have been presented earlier or which are included in a user

compiled set (see paragraph 0019, line 1-4). One of ordinary skill in the art further

recognizes that it is clear from the teachings of Oosterholt that the web pages which is

equivalent to a past-referred to file or data, can be referenced whether the personal

computer is communicating over an external network [i.e. with the remote server] or

while the personal computer is not communicating over an external network, since

Oosterholt teaches "*the retrieval means may download the requested page from a*

remote server or if the page is already available locally, retrieve it from an internal

storage medium."

It would therefore have been obvious to one of ordinary skill in the art at the time

of the invention to modify Nielsen with Oosterholt to include a third display mark which

provides an access-related information allowing said communication terminal to access

a past-referred to file stored in a computer device connected to said communication

network, and said access-related information being linked to said file; and a fourth

display mark which provides at least one executable function related to said past-

referred to file, said reference information having been automatically created in a normal

operation mode of said communication terminal when said past-referred to data was

referred to, and said past-referred to file having been referred to in communication

mode of said communication terminal, in order to enable a user of the computer device

to reference a list of web-pages presented earlier and stored on a remote server as

taught by Oosterholt.

The combination of Nielson and Oosterholt fails to explicitly teach said access-

related information includes a URL address of said past-referred to file, and said URL

address of said past-referred to file having been automatically stored in said

communication mode of said communication terminal when said past-referred to file

was referred to.

In an analogous field of endeavor, Kinnunen teaches a user interface for a

radiotelephone in which a user is able to select components from a variety of sources

including multimedia sources and the Internet, wherein an access-related information

includes a URL address of a past-referred to file, and said URL address of said past-referred to file having been automatically stored in said communication mode of said communication terminal when said past-referred to file was referred to (see p. 2 [0017]). One of ordinary skill in the art further recognizes that Oosterholt's teaching that, the web pages may be represented by a number of web addresses (see paragraph 0021, lines 1-4) in combination with the teachings of Kinnunen meets the claimed limitation of "said URL address of said past-referred to file having been automatically stored in said communication mode of said communication terminal when said past-referred to file was referred to.

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to modify Nielsen and Oosterholt with the teachings of Kinnunen, wherein said access-related information includes a URL address of said past-referred to file, and said URL address of said past-referred to file having been automatically stored in said communication mode of said communication terminal when said past-referred to file was referred to, in order to enable a user of a radiotelephone to access a file held externally on the Internet and to store the URL address of the file internally on the radiotelephone to allow the user to reference the file at his convenience as taught by Kinnunen (see p. 2 [0017]).

Regarding claims 12 and 23, Nielsen teaches a program to be executed to implement a method of controlling a communication terminal accessible to a communication network (see paragraph 0032, lines 3-9, paragraph 0026, lines 6-10 and Figures 3, 4a & 4b), said program and method including: displaying, in a stand-by mode

of said communication terminal (see paragraph 0034, line 1 through paragraph 0035,

line 3, paragraph 0039, lines 6-18, Fig. 2; where a control unit [processor 18] configured

to control display unit [LCD 3] is shown, and Fig. 4a; where layout 30 as presented on

LCD 3, showcases the phone in an idle mode), at least one of: a first display mark

which provides a reference information linked to past-referred to data stored in said

communication terminal (see paragraph 0039, lines 18-25 and Fig. 4a; where Names 60

on LCD 3 enables the user of the phone to access a built in phone book which reads on

past-referred data stored in the phone); and a second display mark which provides at

least one executable function related to said past-referred to data (see paragraph 0039,

lines 18-25, paragraph 0040, lines 1-3, paragraph 0042, line 1 through paragraph 0043,

line 9 and Fig. 4a; shows the steps of selecting among several different menu items

[Names 60 or Menu 55] listed on LCD 3 when the phone is in an idle mode).

Nielsen, however, fails to explicitly teach a third display mark which provides an

access-related information allowing said communication terminal to access a past-

referred to file stored in a computer device connected to said communication network,

and said access-related information being linked to said file; and a fourth display mark

which provides at least one executable function related to said past-referred to file, said

reference information having been automatically created in a normal operation mode of

said communication terminal when said past-referred to data was referred to, and said

past-referred to file having been referred to in communication mode of said

communication terminal.

Oosterholt, however, teaches a personal computer accessible to a communication network, wherein the personal computer enables a user to browse web pages by means of a bookmark (see paragraph 0017, lines 1-5, paragraph 0018, lines 10-11). According to Oosterholt, the user may select a bookmark from a list of earlier defined bookmarks, which causes a retrieval means to retrieve a webpage referenced by the selected bookmark and the retrieval means may download the requested page from a remote server or if the page is already available locally, retrieve it from an internal storage medium (see paragraph 0018, lines 10-17 and Fig. 1; shows a personal computer 101 connected to a remote internet server 102). Oosterholt further teaches the web-pages may be selected by a history means, which maintain a list of references to web-pages which have been presented earlier or which are included in a user compiled set (see paragraph 0019, line 1-4) and the method can be implemented by means of hardware comprising several distinct elements, and by means of a suitably programmed computer (see paragraph 0028, lines 1-3). One of ordinary skill in the art further recognizes that it is clear from the teachings of Oosterholt that the web pages which is equivalent to a past-referred to file or data, can be referenced whether the personal computer is communicating over an external network [i.e. with the remote server] or while the personal computer is not communicating over an external network, since Oosterholt teaches "*the retrieval means may download the requested page from a remote server or if the page is already available locally, retrieve it from an internal storage medium*."

It would therefore have been obvious to one of ordinary skill in the art at the time

of the invention to modify Nielsen with Oosterholt to include a third display mark which

provides an access-related information allowing said communication terminal to access

a past-referred to file stored in a computer device connected to said communication

network, and said access-related information being linked to said file; and a fourth

display mark which provides at least one executable function related to said past-

referred to file, said reference information having been automatically created in a normal

operation mode of said communication terminal when said past-referred to data was

referred to, and said past-referred to file having been referred to in communication

mode of said communication terminal, in order to enable a user of the computer device

to reference a list of web-pages presented earlier and stored on a remote server as

taught by Oosterholt.

The combination of Nielson and Oosterholt fails to explicitly teach said access-

related information includes a URL address of said past-referred to file, and said URL

address of said past-referred to file having been automatically stored in said

communication mode of said communication terminal when said past-referred to file

was referred to.

In an analogous field of endeavor, Kinnunen teaches a user interface for a

radiotelephone in which a user is able to select components from a variety of sources

including multimedia sources and the Internet, wherein an access-related information

includes a URL address of a past-referred to file, and said URL address of said past-

referred to file having been automatically stored in said communication mode of said

communication terminal when said past-referred to file was referred to (see p. 2 [0017]).

One of ordinary skill in the art further recognizes that Oosterholt's teaching that, the web

pages may be represented by a number of web addresses (see paragraph 0021, lines

1-4) in combination with the teachings of Kinnunen meets the claimed limitation of "said

URL address of said past-referred to file having been automatically stored in said

communication mode of said communication terminal when said past-referred to file

was referred to.

It would therefore have been obvious to one of ordinary skill in the art at the time

of the invention to modify Nielsen and Oosterholt with the teachings of Kinnunen,

wherein said access-related information includes a URL address of said past-referred to

file, and said URL address of said past-referred to file having been automatically stored

in said communication mode of said communication terminal when said past-referred to

file was referred to, in order to enable a user of a radiotelephone to access a file held

externally on the Internet and to store the URL address of the file internally on the

radiotelephone to allow the user to reference the file at his convenience as taught by

Kinnunen (see p. 2 [0017]).

Regarding claims 3, 14, and 25, the combination of Nielsen, Oosterholt and

Kinnunen teaches all the limitations of claims 1,12 and 23. Oosterholt further teaches

said computer device comprises a server computer (see p. 2 [0017-0018] and Fig. 1;

shows a personal computer 101 connected to a remote internet server 102).

Regarding claims 4,15, and 26, the combination of Nielsen, Oosterholt and

Kinnunen teaches all the limitations of claims 1,12 and 23. Nielsen further teaches a

communication terminal, program and method, wherein said communication terminal comprises a mobile communication terminal (see paragraph 0032, lines 1-9, paragraph 0026, lines 1-10 and Fig. 1).

Regarding claims 5,16, and 27, the combination of Nielsen, Oosterholt and Kinnunen teaches all the limitations of claims 1,12 and 23. Nielsen further teaches a communication terminal, program and method, wherein said past-referred to data are displayed upon selection of said first display mark (see paragraph 0039, lines 18-25 and Fig. 4a; where Names 60 [first display mark] on LCD 3 enables the user of the phone to access a built in phone book which reads on the past-referred to data stored in the phone).

Regarding claims 6,17, and 28, the combination of Nielsen, Oosterholt and Kinnunen teaches all the limitations of claims 1,12 and 23. Nielsen further teaches a communication terminal, program and method, wherein at least one executable function related to said past-referred to data is displayed upon selection of said second display mark (see paragraph 0039, lines 18-25, paragraph 0040, lines 1-3, paragraph 0042, line 1 through paragraph 0043, line 9 and Fig. 4a; shows the steps of selecting among several different menu items [Names 60 or Menu 55] and Browser 70 reads on a second display mark, since if chosen by the user after referring to either Names 60 or Menu 55 [first display mark], provides an executable related function and causes a selection of different menus related to reference information stored under Names 60 or Menu 55 in the phone).

Regarding claims 7, 18, and 29, the combination of Nielsen, Oosterholt and

Kinnunen teaches all the limitations of claims 1,12 and 23. Oosterholt further teaches

said communication terminal re-accesses said past-referred to file in said computer

device upon selection of said third display mark (see p. 2 [0017-0019]).

Regarding claims 8,19, and 30, the combination of Nielsen, Oosterholt and

Kinnunen teaches all the limitations of claims 1,12 and 23. Oosterholt further teaches a

list of said at least one executable function related to said past-referred to file is

displayed upon selection of said fourth display mark (see p. 2 [0017-0019]).

Regarding claims 9, 20, and 31, the combination of Nielsen, Oosterholt and

Kinnunen teaches all the limitations of claims 1,12 and 23. Nielsen further teaches a

communication terminal, program and method, wherein if further data of the same kind

as past-referred to data are referred to after said past-referred to data have been

referred to, then an additional first display mark which provides an additional reference

information linked to said further data is displayed, instead of said first display mark (see

paragraph 0039, lines 18-25, paragraph 0040, lines 1-4 and paragraph 0042, line 1

through paragraph 0043, line 9 and Fig. 4a).

Regarding claims 10, 21, and 32, the combination of Nielsen, Oosterholt and

Kinnunen teaches all the limitations of claims 1,12 and 23. Nielsen further teaches a

communication terminal, program and method, wherein if further data of a different kind

from said past-referred to data are referred to after said past-referred to data have been

referred to, then not only said first display mark which provides said reference

information linked to said past-referred to data, but also an additional first display mark

which provides an additional reference information linked to said further data are

displayed (see paragraph 0039, lines 18-25, paragraph 0040, lines 1-4 and paragraph

0042, line 1 through paragraph 0043, line 9 and Fig. 4a).

Regarding claims 11, 22, and 33, the combination of Nielsen, Oosterholt and

Kinnunen teaches all the limitations of claims 1,12 and 23. Nielsen fails to explicitly

teach if a further file to said past-referred to file is referred to after said past-referred to

file has been referred to, then an additional third display mark which provides an

additional access-related information allowing said communication terminal to have an

access to said further file is displayed, instead of said file.

Oosterholt, however, teaches a personal computer accessible to a

communication network, wherein the personal computer enables a user to browse web

pages by means of a bookmark (see paragraph 0017, lines 1-5, paragraph 0018, lines

10-11). According to Oosterholt, the user may select a bookmark from a list of earlier

defined bookmarks, which causes a retrieval means to retrieve a webpage referenced

by the selected bookmark and the retrieval means may download the requested page

from a remote server (see paragraph 0018, lines 10-17 and Fig. 1; shows a personal

computer 101 connected to a remote internet server 102). Oosterholt further teaches

the web-pages may be selected by a history means, which maintain a list of references

to web-pages which have been presented earlier or which are included in a user

compiled set (see paragraph 0019, line 1-4). In Figures 3-4, Oosterholt teaches a

method of selecting an additional page E after referring to said past-referred file X,

wherein an additional bookmark (page E), which provides an additional access-related

information allowing said communication terminal to have an access to said further file

is shown in the figures (see paragraph 0022, line 1 through paragraph 0025, line 11 and

Figures 3-5).

It would therefore have been obvious to one of ordinary skill in the art at the time

of the invention to modify Nielsen, Oosterholt and Kinnunen, such that a further file to

said past-referred to file is referred to after said past-referred to file has been referred

to, then an additional third display mark which provides an additional access-related

information allowing said communication terminal to have an access to said further file

is displayed, instead of said file, in order to enable a user of the computer device to

reference a list of web-pages presented earlier and stored on a remote server as taught

by Oosterholt.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   Claims 23-33 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter as follows:

Claims 23-33 recites ""*a program....*" implies a "signal"

modulated/encoded/embodied on a carrier wave/etc. with functional descriptive

material. While functional descriptive material may be claimed as a statutory product

(i.e., a "manufacture") when embodied on a tangible computer readable medium, a

"signal" per se does not fall within any of the four statutory classes of 35 U.S.C. §101. A

"signal" is not a process because it is not a series of steps per se. Furthermore, a

"signal" is not a "machine", "composition of matter" or a "manufacture" because these

statutory classes "relate to structural entities and can be grouped as 'product' claims in

order to contrast them with process claims." (1 D. Chisum, Patents § 1.02 (1994)).

Machines, manufactures and compositions of matter are embodied by physical

structures or material, whereas a "signal" has neither a physical structure nor a tangible

material. That is, a "signal" is not a "machine" because it has no physical structure, and

does not perform any useful, concrete and tangible result. Likewise, a "signal" is not a

"composition of matter" because it is not "matter", but rather a form of energy. Finally, a

"signal" is not a "manufacture" because all traditional definitions of a "manufacture" have

required some form of physical structure, which a claimed signal does not have.

> A "manufacture" is defined as "the production of articles for use from raw
> materials or prepared materials by giving to these materials new forms,
> qualities, properties, or combinations, whether by hand-labor or by
> machinery." Diamond v. Chakrabarty, 447 U.S. 303, 308, 206 USPQ 193,
> 196-97 (1980) (quoting American Fruit Growers, Inc. v. Brogdex Co., 283
> U.S. 1, 11, 8 USPQ 131, 133 (1931).

Therefore, a "signal" is considered non-statutory because it is a form of energy,

in the absence of any physical structure or tangible material, that does not fall within any

of the four statutory classes of 35 U.S.C. §101.

NOTE: Refer to Annex IV, section (c) of the USPTO "Interim Guidelines for

Examination of Patent Applications for Patent Subject Matter Eligibility", Official Gazette

notice of 22 November 2005 (currently at

http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm).

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony S. Addy whose telephone number is 571-272-7795. The examiner can normally be reached on Mon-Thur 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc M. Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.S.A

DUC M. NGUYEN
SUPERVISORY PRIMARY EXAMINER
TECHNOLOGY CENTER 2600